

(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No. : 10/572,176 )  
Confirmation : 4759 )  
 )  
Applicants : Wiedemann et al. )  
U.S. National Phase of )  
PCT/EP2004/010402 )  
 )  
I.A. Filed : September 16, 2004 )  
 )  
Title: HEATING ELEMENT FOR )  
COOKING APPLIANCES )  
 )  
Art Unit : Not yet assigned )  
Examiner : Not yet assigned )  
 )  
Atty Docket : 30931/F50019 )  
Customer No. : 04743 )

**RESPONSE TO NOTIFICATION OF MISSING  
REQUIREMENTS AND PETITION UNDER 37 C.F.R. § 1.47(a)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This petition under the provisions of 37 C.F.R. §1.47(a) is submitted in response to the Notification of Missing Requirements Under 35 U.S.C. § 371 in the United States Designated/Elected Office (DO/EO/US) mailed on June 5, 2006 (copy enclosed herewith).

The facts described below, attested to in the accompanying documents and Declaration of Facts by Dr. Metten, show that named co-inventor Frederic Renaud has refused to sign the inventor's declaration for the above-identified patent application.

Frederic Renaud's last-known residential address is:

12, bld Wallach, F-68100  
Mullhouse  
FRANCE

“If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor.” 35 U.S.C. § 116.

As described in the accompanying Declaration of Facts by Dr. Metten and the documents submitted herewith, named inventor Frederic Renaud was presented with a complete copy of the above-identified patent application and a corresponding inventor’s declaration.

The inventor’s declaration which was provided for execution by Mr. Renaud was identical to that actually executed by the other co-inventors (see signed copies submitted herewith).

An English-language translation of Exhibit A to Dr. Metten’s Declaration of Facts is also submitted herewith.

Mr. Renaud was aware of the final deadline for executing the declaration, yet he refused to join in the application. Instead, he made a further demand for compensation from his former employer in exchange for signing the inventor’s declaration. Mr. Renaud’s refusal to sign the inventor’s declaration was unrelated to any dispute regarding the content of the application or his status as a properly-named inventor, but rather was strictly motivated by the desire for additional compensation.

Accordingly, the facts show that inventor Meyer refused to join in the application by executing the required inventor’s declaration for the U.S. national phase application. 35 U.S.C. § 116. The petition should be granted.

### **Conclusion**

On the basis of these facts and for the foregoing reasons, it is solicited that the U.S. Patent and Trademark Office grant a patent on this application to the inventors making the application, subject to the same rights which the non-signing inventor would have had if he had joined.

Should the Petitions Officer have any question of form or substance, he or she is encouraged to contact the undersigned attorney at the telephone number and address listed below.

Respectfully submitted,  
MARSHALL, GERSTEIN & BORUN LLP

By: /Michael Muczynski/ 48,642

January 4, 2007

Michael Muczynski  
Reg. No. 48,642  
Attorney for Applicants

6300 Sears Tower  
233 South Wacker Drive  
Chicago, IL 60606  
(312) 474-6300

**DECLARATION OF FACTS**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Wiedemann et al.

Application No.: 10/572,176

Confirmation No. 4759

Filed: September 16, 2004

Art Unit: Not Yet Assigned

For: Heating Element For Cooking Appliances

Examiner: Not Yet Assigned

**DECLARATION OF FACTS FOR PETITION UNDER 37 C.F.R. 1.47(A)**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

I, Dr. Karl-Heinz Metten, of Boehmert & Boehmert, hereby state as follows:

1. I make this Declaration of Facts regarding facts and circumstances known to me concerning the inability to secure a signed or executed Declaration of one of five co-inventors in U.S. Patent Application Serial No. 10/572,176 (hereinafter "the '176 application").
2. I am authorized by Rational AG (hereinafter "Rational") and Frima SA (hereinafter "Frima"), the assignees of the '176 application, to make these statements as legal counsel.

3. To date, neither I nor anyone at Rational, Frima, Boehmert & Boehmert, or Marshall, Gerstein & Borun LLP has been able to obtain an executed inventor's declaration for the '176 application from inventor Frederic Renaud. Mr. Renaud is a former employee of Frima and is named as a co-inventor of the subject matter claimed in the '176 application.

4. The last known residential address for Mr. Renaud is:

12, bld Wallach, F-68100  
Mullhouse  
FRANCE

5. On or about July 27, 2004, Mr. Renaud's employment with Frima was terminated.

6. At some time after July 27, 2004, Mr. Renaud and Frima became involved in a legal dispute in France. The legal dispute was not related to whether Mr. Renaud is a co-inventor in the '176 application.

7. Frima's legal representative in the legal dispute recommended that we delay direct contact with Mr. Renaud, including seeking his signature on the inventor's declaration for the '176 application, until the legal dispute was concluded.

8. I was informed that on December 21, 2006 Frima and Mr. Renaud had reached a settlement agreement in the legal dispute, and that Mr. Renaud was expected to sign the declaration for the '176 application.

9. On or about December 21, 2006, the attorney of Mr. Renaud was sent a copy of the above-identified patent application and an inventor's declaration prepared by Marshall Gerstein & Borun LLP for the application. A copy of the letter of the French attorney of Frima addressed to Mr. Renaud's attorney having had these documents enclosed is attached hereto as

Exhibit A.

10. Mr. Renaud's attorney, when discussing the above-mentioned settlement agreement, was informed of the non-extendable deadline of January 5, 2007, for filing the signed inventor's declaration with the United States Patent & Trademark Office, and that a failure to return the executed declaration or a copy thereof by January 3, 2007, would be considered a refusal to join in the application.

11. We did not receive the signed inventor's declaration from Mr. Renaud by January 3, 2007.

12. On January 4, 2007, I spoke with Mr. Renaud by telephone. In the telephone conversation, Mr. Renaud acknowledged that he had direct access to and had seen the above-identified U.S. patent application and the inventor's declaration which was prepared by colleagues at Marshall, Gerstein & Borun LLP, and was aware of the deadline for submitting the inventor's declaration. Mr. Renaud had accessed the documents via his French attorney who represented him in a dispute with Frima unrelated to his status as a co-inventor.

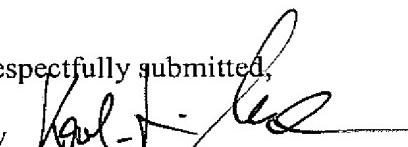
13. In the telephone conversation I had with Mr. Renaud on January 4, 2007, he acknowledged that he was an inventor of the subject matter claimed in the invention, and he expressed that he would be able to immediately sign the inventor's declaration. However, Mr. Renaud said that he was unwilling to sign the inventor's declaration unless he was paid an additional sum of money.

14. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. I hereby further

declare that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued therefrom.

Dated: January 4, 2007

Respectfully submitted,

By   
Dr. Karl-Heinz Metten  
Boehmert & Boehmert  
Freiherr-vom-Stein-Strasse 7  
60323 Frankfurt am Main  
Germany

**Exhibit A  
to Declaration of Facts  
by Dr. Karl-Heinz Metten**

# FIDAL

13, rue de Chemnitz  
Parc d'Activités de la Mer Rouge  
68068 Mulhouse Cedex  
Tél : 03 89 33 29 33 - Fax : 03 89 33 29 30

CL NANCY  
30002 07323 000066215E78  
Barreau de Mulhouse

SCP SIMON, WURMSER, SCHWACH,  
BOUDIAS et FREZARD  
A l'attention de Maître Nicolas FREZARD

8 rue de la Justice

68100 MULHOUSE

**RECOMMANDÉE A.R.**  
*(par précaution)*

DROIT  
FISCAL

Mulhouse, le 21 décembre 2006

DROIT  
À GESTION  
SOCIALE

V/réf :  
N/réf : MS/PG/DJ

DROIT  
DES SOCIÉTÉS

Objet : Aff RENAUD c/ FRIMA

CONCURRENCE  
DISTRIBUTION

Cher Confrère,

PROPRIÉTÉ  
INTELLECTUELLE

Veuillez trouver ci-joint en deux exemplaires, le protocole d'accord valant transaction, désistement d'instance et d'action dans le dossier cité sous objet ainsi qu'un chèque CREDIT MUTUEL n° 1221274 d'un montant de 23 000 € à l'ordre de la CARPA.

TECHNOLOGIES  
DE L'INFORMATION

Je vous remercie de bien vouloir faire parapher chaque page des exemplaires et faire précéder la signature de la mention manuscrite « *Lu et approuvé, bon pour transaction définitive et irrévocable et renonciation à toute action et instance* » par votre client.

DROIT  
MATRIMONIAL

Je joins également à la présente, un dépôt de brevet en deux exemplaires que Monsieur RENAUD voudra bien parapher et signer.

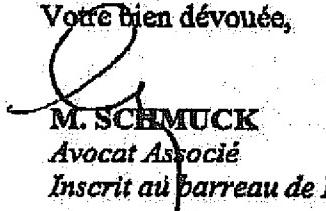
JUDICIAIRE

Vous voudrez bien me retourner un exemplaire de ladite transaction ainsi que les deux exemplaires dudit dépôt de brevet.

DROIT  
FINANCIE

Je vous souhaite bonne réception des présentes et vous prie de me croire, Cher Confrère,

Votre bien dévouée,

  
M. SCHMUCK  
Avocat Associé  
Inscrit au barreau de Mulhouse

**Exhibit A (English Translation)  
to Declaration of Facts  
by Dr. Karl-Heinz Metten**



13, rue de Cheminot  
Parc d'Activités de la Mer Rouge  
68068 Mulhouse Cedex  
Tél : 03 89 33 29 93 - Fax : 03 89 33 29 30

CL NANCY  
30002 07325 000060213K7B  
Barreau de Mulhouse

**SCP SIMON, WURMSEER, SCHWACE  
BOUDIAS et FREZARD**

To the attention of Attorney Nicolas FREZARD

REGISTERED  
(as a precaution)  
Mulhouse, December 21, 2006

8 rue de la Justice  
68100 MULHOUSE

Your ref :  
Our ref : MS/PG/DJ

Subject: Case RENAUD vs. FRIMA

Dear Colleague,

Enclosed please find two copies of the record of the contract relating to the transaction, withdrawal of the suit and claim in the file cited on the subject as well as a check on CREDIT MUTUEL No. 12212274 in an amount of € 23,000 to the order of CARPA.

I would appreciate it if your client would initial each page of the copies and precede the signature with the handwritten statement "*Read and approved, good for definitive and irrevocable transaction and renunciation of any claim and suit*".

I am also attaching to this letter a filing of the patent in two copies that Mr. RENAUD should initial and sign.

Please return to me a copy of the said transaction as well as the two copies of the patent filing.

With best wishes, sincerely

M. SCHMUCK  
Associate Counsel  
Registered at the Bar of Mulhouse

FIDAL - Société d'impôts  
Société d'économie mixte  
à forme anonyme à directoire  
et conseil de surveillance

Capital : 2 650 000 Euros  
 RCS 773126139 Nanterre  
 TVA Union Européenne  
 FR 29 771 728 517 - APF 741 A

Siège social : 12 Bd du Général Leclerc  
92100 Neuilly sur Seine - France  
Tél : 01 57 39 51 00 - [www.fidal.fr](http://www.fidal.fr)  
Bureau de Paris 92100 Neuilly-sur-Seine



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 450  
 Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/572,176	Peter Wiedemann	30931/F50019

04743  
 MARSHALL, GERSTEIN & BORUN LLP  
 233 S. WACKER DRIVE, SUITE 6300  
 SEARS TOWER  
 CHICAGO, IL 60606

RECEIVED

JUN 12 2006

MARSHALL GERSTEIN

Date Mailed: 06/05/2006

INTERNATIONAL APPLICATION NO.

PCT/EP04/10402

I.A. FILING DATE      PRIORITY DATE

09/16/2004      09/16/2003

CONFIRMATION NO. 4759

371 FORMALITIES LETTER



\*OC000000019109700\*

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 03/16/2006
- Copy of the International Search Report filed on 03/16/2006
- Copy of IPE Report filed on 03/16/2006
- Preliminary Amendments filed on 03/16/2006
- Information Disclosure Statements filed on 03/16/2006
- U.S. Basic National Fees filed on 03/16/2006
- Substitute Specification filed on 03/16/2006
- Priority Documents filed on 03/16/2006

Docketed: 8-5-06

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.492(h) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.

#### SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$130** for a Large Entity:

- \$130 Surcharge.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

CHARITTA A BURT

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Telephone: (703) 308-9140 EXT 207

PART 1 - ATTORNEY/APPLICANT COPY

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U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/572,176	PCT/EP04/10402	30931/F50019

FORM PCT/DO/EO/905 (371 Formalities Notice)